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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/719,881 | 01/10/2001 | Frank Puttkammer | 000437 | 7109 |

31518 7590 06/02/2006

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| EXAMINER |
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FRIDIE JR, WILLMON

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| ART UNIT | PAPER NUMBER |
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3722

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,881

Applicant(s)

PUTTKAMMER ET AL.

Examiner

Willmon Fridie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30,31,33-39,41-50 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39 and 41-48 is/are allowed.
- 6) ☒ Claim(s) 30,31,33-38,49,50 and 52-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 30,31, 33-39,41-50 and 52-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule in view of Majumdar..

Kaule discloses a security element having an embedded security element in the form of a thread or strip comprising at least one carrier sheet; at least one layer of metal associated with the carrier sheet; and at least one other electrically conductive layer associated with the carrier sheet and coextensive with the metal layer, said other layer comprising an electrically conductive non-metallic material comprising electrically conductive pigments or electrically conductive plastic directly adjacent and electrically connected with the metal layer, whereby said other layer maintains electrical continuity of said metal layer in case said metal layer is rendered electrically discontinuous by

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breakage but lacks the disclosure of the use of polyethylene dioxthiophene polystyrene sulfonyl in its security element. Majumdar discloses an imaging element, which includes a support, an image-forming layer superposed on the support, and an electrically conductive layer superposed on the support. The electrically conductive layer includes a layered siliceous material; an electrically conducting polymer that can intercalate inside or exfoliate said layered siliceous material and a film-forming binder. Majumdar teaches that it is well known in the art to use a polyethylene dioxthiophene polystyrene sulfonyl in a security document (see column 12, lines 31-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Kaule with a polyethylene dioxthiophene polystyrene sulfonyl in its security element in the manner as taught by Majumdar in order to provide the assembly with another deterrent to fraudulent tampering.

In regard to claims 33,36,37 and 52-56, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed combinations of materials, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. The specifics would also depend on the the authentication device/fraud detection device employed by the end user and the parameters that are chosen for verification.

In regard to claim 38, the examiner takes official notice of the use of a watermark on a substrate of a security document. The use of such is deemed to be old and well known in the art.

With respect to claims 57-61, the various limitations directed to the pattern of the PEDT/PSS and its composition would have been obvious to one having ordinary skill in the art at the time the invention was made to since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Further, it appears that there would be no new or unexpected result from such a modification.

Allowable Subject Matter

Claims 39 and 41-48 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willmon Fridle whose telephone number is 571 272 4476. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571 272 4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLMON FRIDIE, JR.
PRIMARY EXAMINER**